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EXAMINER

KUDDUS, DANIEL A

ART UNIT	PAPER NUMBER
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/583,476	Applicant(s) MARTIN ET AL.	
	Examiner DANIEL KUDDUS	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive filed on October 09, 2009. Claims 11-20 are pending and have been considered below.

Objection

2. Claims 11-17 are objected to because of the following informalities:

In claim 11, “a method of backing up...” should read as “A computer implemented method of backing up”.

Claims 12 and 13 are duplicate claims and they are recited similar claim languages.

Appropriate correction is required.

Any claim not specifically addressed, above, is being objected as incorporating the deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 18 is rejected under 35 U.S.C. §101 because the claimed invention is directed to a non statutory subject matter.

In claim 18, ‘a server’ and ‘means for’ is being recited, without having any hardware component. The claim lacks the necessary physical articles or objects to constitute a machine. Therefore, claim 18 is non-statutory. As such, the claimed system does not define any specific

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hardware and needs to be amended to include physical computer hardware (e.g. processor, memory) to execute the components.

Claim Rejections-35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 11, 18 and 19 are rejected under 35 U.S.C. 102(b) as being Sarskog, Johan (WO 01/62029 A1), hereinafter Sarskog.

As for claim 11, Sarskog teaches **a method of backing up personal data of a wireless communication network subscriber, the personal data being memorised in a mobile communication device and backed up in a network server** (see abstract, figure 1), **wherein said method includes an asynchronous backup mode in which, once the mobile communication device has prepared a first subset of data from among a batch of data to be backed up and transmitted the first subset of data to a network server for backing up** (see page 1, line 31 to page 3, line 18), **the backup is delayed by a predetermined period of time, so as to free the mobile device for a user of the mobile communication device and the backup of at least one subset of data subsequent to the first subset of data is resumed at the end of said predetermined period of time** (see page 2, line 1-6, page 2, line 25-30).

Claim 18 have the same subject matter as claim 1 except for the limitation of server for backing up and Sarskog teaches such limitation (see figure 1). Therefore, claim 18 is rejected for the same reason as applied to claim 1 hereinabove.

Claim 19 have the same subject matter as claim 1 except it is directed to portable wireless communication device and Sarskog teaches such limitation (see figure 1) and is rejected for the same reason as applied to claim 1 hereinabove.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 11, 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Reenen et al. (WO 03/037015 A1), hereinafter Van.

As for claim 11, Van teaches **a method of backing up personal data of a wireless communication network subscriber, the personal data being memorised in a mobile communication device and backed up in a network server** (see abstract, figure 1), **wherein said method includes an asynchronous backup mode in which, once the mobile communication device has prepared a first subset of data from among a batch of data to be backed up and transmitted the first subset of data to a network server for backing up** (see page 2, line 13 to page 4, line 6), **the backup is delayed by a predetermined period of time, so as to free the mobile device for a user of the mobile communication device and the backup**

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of at least one subset of data subsequent to the first subset of data is resumed at the end of said predetermined period of time (see page 4, line 7 to page 6, line 16).

Claim 18 have the same subject matter as claim 1 except for the limitation of server for backing up and Van teaches such limitation (see figure 1). Therefore, claim 18 is rejected for the same reason as applied to claim 1 hereinabove.

Claim 19 have the same subject matter as claim 1 except it is directed to portable wireless communication device and Van teaches such limitation (see figure 1) and is rejected for the same reason as applied to claim 1 hereinabove.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dormehi et al. (WO 03/007639 A1), hereinafter Dormehi and further in view of Jouenne et al. (US 6,286,085 B1), hereinafter Jouenne.

As for claim 11, Dormehi teaches **method of backing up personal data of a wireless communication network subscriber, the personal data being memorised in a mobile communication device and backed up in a network server** (see abstract, page 2, line 1-14), **wherein said method includes, in which, once the mobile communication device has prepared a first subset of data from among a batch of data to be backed up and transmitted the first subset of data to a network server for backing up** (see page 1, line 6-10, page 3, line 3 to page 4, line 18, server being programmed to receive uploaded data from the memory of a mobile telephone; to store same in the associated database record and in the event that the relevant data base record already has existing data stored therein, figure 1), **the backup is delayed by a predetermined period of time, so as to free the mobile device for a user of the mobile communication device and the backup of at least one subset of data subsequent to the first subset of data is resumed at the end of said predetermined period of time** (see page 3, line 18-28, data stored in the relevant data base record under predetermined conditions by way of the internet; for release of the data stored in a data base record to be dependent upon the supply of security information, page 5, line 9 to page 8, line 24, the database record may be subdivided into sub-records, if required so that data of a different nature can be separated out).

Dormehi does not explicitly teach the limitation of an asynchronous backup. Jouenne teaches such limitation (see column 1, line 48-50, e.g. asynchronous type backup).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified the teaching of Dormehi by applying the teaching of Jouenne to backing up data and results in a system in which backup is optimized under all situations. Further, data backup would be secure and prevent any data loss between stations (see Jouenne, column 1, line 55-62).

As for claim 12, Dormehi teaches **wherein, in order to resume the backup, the mobile device implements a countdown of the period and sends a resume signal to a chip card in the mobile device at the end of said period** (see page 5, line 9-19).

As for claim 13, Dormehi teaches **wherein, in order to resume the backup, the mobile device implements a countdown of the period and sends a resume signal to a chip card in the mobile device at the end of said period** (see page 5, line 9-19).

As for claim 14, Dormehi teaches **wherein the mobile implements the countdown and sends the resume signal upon receiving an instruction from the chip card** (see page 5, line 9-19).

As for claim 15, Dormehi teaches **wherein the chip card gives said instructions to the mobile device by sending it a Subscriber Identity Module toolkit (“STK”) command** (see page 3, line 18-32).

As for claim 16, Dormehi teaches **wherein the chip card gives instructions by means of ‘GET STATUS’ commands** (see page 2, line 7-14).

As for claim 17, Dormehi teaches **a prior assessment step which determines whether the volume of data to be backed up or a corresponding waiting time required to make the mobile device available to the user is determined and compared to a predetermined**

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threshold (see page 2, line 16-22, page 3, line 10-16), **when the volume of data higher than the predetermined threshold, the backup is performed, when the volume of data is not higher than the predetermined threshold, the backup is carried out according to default mode** (see page 3, line 18 to page 4, line 2).

Dormehi does not explicitly teach according to the asynchronous backup mode. Jounne teaches such limitation (see column 1, line 48-50).

Claim 18 have the same subject matter as claim 1 except for the limitation of server for backing up and Dormehi teaches such limitation (see figure 1). Therefore, claim 18 is rejected for the same reason as applied to claim 1 hereinabove.

Claim 19 have the same subject matter as claim 1 except it is directed to portable wireless communication device and Dormehi teaches such limitation (see figure 1) and is rejected for the same reason as applied to claim 1 hereinabove.

As for claim 20, Dormehi teaches **wherein said device selectively operates, and a normal mode** (see page 6, line 30 to page 7, line 4).

Dormehi does not explicitly teach according to the asynchronous backup mode. Jounne teaches such limitation (see column 1, line 48-50).

Conclusion

7. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Daniel A Kuddus whose telephone number is (571) 270-1722. The examiner can normally be reached on Monday to Thursday 8.00 a.m.-5.30 p.m. The examiner can also be reached on alternate Fridays from 8.00 a.m. to 4.30 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or processing is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from the either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel Kuddus

Date: 03/11/10

/Charles Rones/

Supervisory Patent Examiner, Art Unit 2164